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AUG 09 2002

OFFICE OF PETITIONS

In re Application of :
Rogers et al. :
Application No. 10/058,564 : DECISION DISMISSING REQUEST
Filed: 28 January, 2002 :
Attorney Docket No. D-7227A :

~~In re Application of :
Rogers et al. :
Application No. 10/058,746 :
Filed: 30 January, 2002 :
Attorney Docket No. D-7727A :~~

This is a decision on the request for refund received 22 February, 2002, requesting that the \$780 fees (\$740 basic filing fee and \$40 assignment recording fee) submitted with the application assigned Application No. 10/058,564 be refunded.

The application was purportedly deposited with the U.S. Postal Service on 17 December, 2001, but was received in the U.S. Patent and Trademark Office (USPTO or Office) on, and accorded a filing date of, 30 January, 2002, and assigned Application No. 10/058,746. Applicants state that "[t]he first sent application was delayed due to the irradiation problem of the mail and applicants needed to have the application filed prior to the time that the first sent application was actually received and given Serial No. and filing date of 10/058746, 01/30/02." Applicants subsequently sent a new application by USPS Express Mail on 28 January, 2002, which was assigned Application No. 10/058,564 and accorded a filing date of 28 January, 2002.

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It is noted that there was no indication in the application papers filed on 28 January, 2002, and assigned Application No. 10/058,564, that the application was a duplicate of a previously submitted application.¹

The fact that applicant has filed duplicate or substantially duplicate applications does not entitle applicant to a refund of the filing fee. The application papers filed on 28 January, 2002, as Application No. 10/058,564, are entitled to a filing date of 28 January, 2002, and the filing fee paid in application No. 10/058,564 is the fee required by law. Similarly, the application papers filed on 30 January, 2002, as Application No. 10/058,746, are entitled to a filing date of 30 January, 2002, and the filing fee paid in Application No. 10/058,746 is the fee required by law. Additionally, as the assignment recordation fee was not paid by mistake or in excess of that required, applicant is not entitled to a refund thereof.

37 CFR 1.26(a) reads:

(a) The Commissioner may refund any fee paid by mistake or in excess of that required. **A change of purpose after the payment of a fee, such as when a party desires to withdraw a patent or trademark filing for which the fee was paid, including an application, an appeal, or a request for an oral hearing, will not entitle a party to a refund of such fee.** The Office will not refund amounts of twenty-five dollars or less unless a refund is specifically requested, and will not notify the payor of such amounts. If a party paying a fee or requesting a refund does not provide the banking information necessary for making refunds by electronic funds transfer (31 U.S.C. 3332 and 31 CFR part 208), or instruct the Office that refunds are to be credited to a deposit account, the Commissioner may require such information, or use the banking information on the payment instrument to make a refund. Any refund of a fee paid by credit card will be by a credit to the credit card account to which the fee was charged. (Emphasis added).

Section 607.02 of the Manual of Patent Examining Procedure, Eighth Edition (August 2001) reads, in part, as follows:

¹It is noted that the cover sheet received with Application No. 10/058,564 was hand-notated "resubmitted [check] # 14702 \$780.00." It is not apparent from this notation by itself, however, that the application is a duplicate.

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Under 35 U.S.C. 42(d) and 37 CFR 1.26, the Office may refund: (1) a fee paid by mistake (e.g., fee paid when no fee is required); or (2) any fee paid in excess of the amount of fee that is required. See *Ex parte Grady*, 59 USPQ 276, 277 (Comm'r Pat. 1943) (the statutory authorization for the refund of fees under the "by mistake" clause is applicable only to a mistake relating to the fee payment). **When an applicant or patentee takes an action "by mistake" (e.g., files an application or maintains a patent in force "by mistake"), the submission of fees required to take that action (e.g., a filing fee submitted with such application or a maintenance fee submitted for such patent) is not a "fee paid by mistake" within the meaning of 35 U.S.C. 42(d).** 37 CFR 1.26(a) also provides that a change of purpose after the payment of a fee, as when a party desires to withdraw the filing of a patent application for which the fee was paid, will not entitle the party to a refund of such fee. (Emphasis added and error corrected).

Accordingly, the request is dismissed.

In reference to Application No. 10/058,746 applicants request that the application "be canceled in its entirety." This statement will not be treated as a request to expressly abandon Application No. 10/058,746. If applicant wants to abandon an application, he should file a letter of express abandonment in compliance with 37 CFR 1.138 in the application he wishes to abandon. The letter of express abandonment must be signed by the applicant.

Application No. 10/058,564 is being forwarded to Technology Center 3700 for examination in due course.

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Telephone inquiries specific to this matter should be directed to the undersigned at (703)308-6918.



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